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EXAMINER

MILLER, BENA B

ART UNIT

PAPER NUMBER

3712

DATE MAILED: 01/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/989,696

Applicant(s)

SHAMITOFF, JOEL B.

Examiner

Bena Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 3-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-22 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with indefiniteness that is too numerous to point out in every instance. The following examples are provided for the applicant's use in making corrections wherever appropriate but not specifically pointed.

Regarding claim 3, it appears applicant recites an improper Markush grouping of the claim. For example only, applicant recites "snappable elements, including at least of: one of one or more legs". The examiner is unclear as to what is meant by the phrase "one of one or more legs". Furthermore, it is unclear as to what is the relationship between the recited elements of the Markush grouping. For example only, it is unclear how the automobile relates to the one or more torsos or the one or more arms. Yet in another example, it is unclear how one or more portions of an airplane relates to one or more portions of a train. Also, there is lack of antecedent basis for the claimed limitation "said one or more legs".

It should be noted that a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of

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the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance claim 3 recites the broad recitation one or more blocks, and the claim also recites characters and/or letters which is the narrower statement of the range/limitation.

Regarding claim 8, it is unclear to the examiner the relationship between the claim elements of the Markush grouping. For example only, it is unclear as to how the mustache is related to the one or more animal trunks. Furthermore, it is unclear if the "snap portion" of line 15 is the same as one of the snap portions of claim 3.

Regarding claim 9, the examiner is unsure if applicant is claiming the combination of the toy and the toy classes or the subcombination of the toy only. This in turn, while line 1 of the claim appears to indicate that the applicant intention is to claim only the toy, other portions of the claim recite limitations which are dependent on the toy classes (note lines 10-29 of the claim, for example only). In this office action, the examiner presumes that the applicant's intention is to prosecute the subcombination of the toy, in order to that the claims are given their broadest reasonable interpretation.

All additional limitations that are dependent on the toy classes are not considered further structurally limiting with respect to the claimed toy. On the other hand, clarification of the scope of the claim is required. (It should be noted that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138) Furthermore, the phrases "a toy class capable of being combined to form a toy model of an object known with said toy class" and "a toy class capable of being combined to form a toy model of an unknown object within said toy class" is confusing. For example only, what object is considered to be known or unknown?

In several instances, applicant recites the phrase the "snappable elements may comprise". It is unclear to the examiner whether or not if the snappable comprises a particular element(s) or feature(s). For example only, in claim 10, it is unclear as to whether or not the snappable element comprise portions of a toy model. Yet in another instance, in claim 13, it is unclear as to whether or not the snappable elements comprises at least a first portion of the a toy model. It should be noted a broad range or limitation followed by linking terms (e.g., preferably, maybe, may, for instance, especially) and a narrow range or limitation within the broad range or limitation is considered indefinite since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since

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the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 21 recites the broad recitation one or more universal snap portions, and the claim also recites one of a first snap portion having a first size, a second snap portion have a second size, and a third snap portion have a third size different which is the narrower statement of the range/limitation.

The claims are so indefinite and vague for the reasons noted above that their scope can not be determined with substantial certainty. Clarification of the scope of the claims is required in response to this Office Action.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3 and 8-18 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Alger.

Regarding claims 3 and 9, as best as understood, Alger teaches in figures 1-10 a toy comprising one or more arm snappable elements (14) having one male snap portion (16) where the male snap portion is capable of mating and detaching from the a female portion (18) and a doll formed by the snappable elements (fig. 5).

Regarding claim 8, as best as understood, Alger further teaches one or more eyes (84) having a snap portion (86) for mating with one head (fig.6).

The examiner takes the position that the functional recitations of claims 10-18 are inherently taught in the device of Alger.

Claims 21 and 22 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Hay.

Regarding claim 20, as best as understood, Hay teaches in figures 1-10, snappable elements (6, 23, 24), having one or more universal portions (20, 25, 21, 16) where the universal portions includes a first snap portion (20, figure 2), a second snap portion (21 on the right side of 5 in figure 2) and a third snap portion (21 on the left side of 5 in figure 2; it should be noted that the left side of 5 in figure 2 inherently has an aperture since fig. 1 shows element 19 attached to 6) and the first snap portion capable of mating with both the second snap portion and the third snap portion.

Regarding claim 22, Hay further teaches that the first snap portion is capable of mating with and detaching from the second and third snap portions as seen in figure 2.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 19 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Alger in view of Divvleeon.

Alger teaches in the figures most of elements of the claimed invention, as noted above. However, Alger fails to teach the snappable elements formed of a plush material. Divvleeon teaches in figures 1-5 a plush toy having attachable members (16, 52) that are attached toy. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate plush as taught by Divvleeon for the snappable elements of Alger for the purpose of allowing a child to hold squeeze and play with the toy (col. 2, par. 4).

Claims 5 and 20 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Alger in view of Rodgers.

Alger teaches in the figures the invention most of the elements of the claimed invention as noted above. However, Alger fails to teach a pliant endoskeleton covered by a polymer. Rodgers teaches in figures 1-16 a doll, which has connecting elements as seen in figures 2 and 3, having a pliant endoskeleton (16) where the endoskeleton is covered by a polymer (fig. 2 and 3; note the torso of figures 2 and 3 may be formed from a suitable plastic—col. 2, par. 6). It would have been obvious to one having ordinary skill in the art at the time the invention to incorporate a pliant endoskeleton



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covered by a polymer as taught by Rodgers for the snappable elements of Alger for the purpose of representing various different human races or ethnic groups (col. 1, par. 1).

Claims 6 and 7 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Alger in view of Millard.

Alger teaches in the figures the invention most of the elements of the claimed invention as noted above. However, Alger fails to teach a male to male connector and a female to female connector. Millard teaches a doll having attachable elements (4) using a male to male connector (10) and female to female connector (11) to connect the elements to the torso of the body (fig. 6 and 7). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a male to male connector and a female to female connector as taught by Millard for the snap portions of Alger for the purpose of holding the attachable elements at a greater distance from the body (col. 3, par. 4).

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***


Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bena Miller whose telephone number is 703.305.0643. The examiner can normally be reached on Monday-Friday.

bbm  
January 23, 2003



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